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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,919	01/27/2000	Dale Burns		9242

7590 04/05/2006
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EXAMINER

DADA, BEEMNET W

ART UNIT PAPER NUMBER

2135

DATE MAILED: 04/05/2006

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/491,919
Filing Date: January 27, 2000
Appellant(s): BURNS ET AL.

MAILED

APR 05 2005

Technology Center

Christopher B. Kilner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 20, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The grounds of rejection has changed. The changes are as follows:

Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Council US Patent 6,192,114 in view of Hypponen et al. US Pub 2003/0191957 A1.

Claims 2-4, 6-7 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Council US Patent No. 6192114 A in view of Hypponen US Pub 200310191957 A1, and further in view of Hardy et al. US Patent No. 6073242 A.

Claims 5, 8, 9, 14 and 15 are allowable over the prior art of record.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Prior Art of Record

US 6,192,114 B1	Council	02-20-2001
US 2003/0191957 A1	Hypponen et al	10-09-2003
US 6,073,242	Hardy et al	06-06-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Council US Patent 6,192,114 in view of Hypponen et al. US Pub 2003/0191957 A1 (hereinafter Hypponen).
2. As per claim 1 and 10, the limitation of an email screening system is disclosed by Council, [column 3, lines 22-25]. The limitation of a sender and a recipient connected to a network is disclosed in column 3, lines 14-19 and Figure 1, and the limitation that the email screening server is also connected to the same network screening email of the recipient is disclosed in column 3, lines 19-24, lines 39-40. The limitation that the email-screening server that the email will be forwarded to the recipient for fee is disclosed in column 1, lines 30-33, Figure 2. Council is silent on computer instructions for screening of email for virus. Hypponen teaches a recipient system (mail server and user work stations, see figure 1, units 4b & 2a-d)

comprising software instruction for forwarding email messages to email screening server (virus scanning server see figure 1, unit 7) (see page 2, 0035-0036 & 0040-0041]. Both Council and Hypponen teach a means for screening email messages for viruses. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the teachings of Hypponen within the system of Council in order to further allow centralized email screening by forwarding received email to a screening system and further enhance the security of the system.

3. Claims 2-4, 6-7 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Council US Patent No. 6192114 A in view of Hypponen US Pub 200310191957 A1, and further in view of Hardy et al (hereinafter Hardy) (US Patent No. 6073242 A).

4. As per claims 2 and 11, Council-Hypponen is silent with regards to the limitation that a password is used as a means of discerning authorized mail to the user. Council teaches the use of an authorization list. Hardy teaches the use of passwords as a means of authorization (Column 9, 15-17). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Hardy within the combination of Council and Hypponen. One of ordinary skill in the art at the time the invention was made would have been motivated to use a password system as opposed to an authorization list because such list are difficult to keep updated.

5. As per claim 3, the screener holding email without a password. It is included in the Council-Hypponen system, since if the sending part is not authorized to send electronic mail to the recipient then the sending party is asked to provide a fee for delivery to the recipient

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(Column 1, lines 28-33). Council further teaches allowing storage of the message when address that is not in the list of authorized address is received [see Council column 2, lines 33-44].

6. As per claim 4, alerting the recipient that an email message is being held by the screening computer which is without password authorization is disclosed by Council. Council any or all of the fee may be paid by the receiving party, which implies that the receiving party must be alerted to authorized mail in order to be given a chance to pay the fee.

7. As per claim 6, the limitation of a method for screening email, which screens the email for viruses and forwards to recipient if password authorized but holds email if not password authorized is disclosed by the Council-Hypponen-Hardy combination. In particular Council describes the email scanner with authorization list [Column 1, lines 29-33 and Column 3, lines 15-40], Hardy modifies this to allow password authorization [Column 9, lines 15-18] and Hypponen teaches a recipient system (mail server and user work stations, see figure 1, unit 4b & 2a-d) comprising software instruction for forwarding email messages to email screening server (virus scanning server see figure 1, unit 7) [see page 2, 0035-0036 & 0040-0041]. Motivation to combine Council and Hardy is that authorization list are too difficult to keep updated, motivation to modify by Hypponen is in order to further allow centralized email screening by forwarding received email to a screening system and further enhance security of the system.

8. As per claim 7, the limitation of notifying the sender and recipient was addressed in claim 4 and charging the sender fees [see Figure 2 of Council].

9. As per claim 12, the method of automatically forwarding password authorized email to recipient (Council Figure 2, Hardy Column9, lines 15-17).
10. As per claim 13, the limitation of notifying sender that email is not password authorized and charging a fee to sender for delivery is disclosed in Council Figure 2, and Hardy (Column 9, lines 15-17).

Allowable Subject Matter

11. Claims 5, 8, 9, 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(10) Response to Argument

Grounds I

With respect to claims 1 and 10, Appellant argued that the office action fails to provide a proper motivation to combine Council with Hypponen et al.

In response to applicant's argument that there is no suggestion to combine the Council with Hypponen et al, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Council teaches a recipient computer connected to an email screening server [see Council, column 3, lines 14-19 and figure 1]. Hypponen et al.

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teaches a recipient system (mail server and user work stations, see figure 1, unit 4b & 2a-d) comprising software instruction for forwarding email messages to email screening server (virus scanning server see figure 1, unit 7) [see page 2, 0035-0036 & 0040-0041]. The teachings of Hypponen wherein received email message is redirected to a screening server [page 2, 0035-0036] can be employed within Council's recipient computer and screening server in order to allow centralized email screening by forwarding received email to a screening system [see Hypponen, page 1, 0003].

Appellant further argued that Hypponen et al still ascribes to the prior art method of virus scanning by intercepting at a firewall/gateway prior to ever being delivered to a recipient computer. Although Hypponen et al suggests the re-routing of certain types of data to a screening server it still relies on a few "protected systems" to intercept and re-route the mail, and the system will not work when a user is attached to the network with the "protected system." In the present invention, the recipient computer can be connected to any network, not just a protected one.

Examiner would point out that In response to Appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the recipient computer can be connected to any network not just a protected one) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant further argued that, in the system of Hypponen et al., only certain data are intercepted and scanned and Hypponen et al fails to teach or fairly suggest a recipient computer.

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with software instructions for forwarding all email messages received to the email screening server.

Examiner would point out that, Hypponen et al teaches a recipient computer (i.e., mail server and user workstations, see figure 1, units 4b & 2a-d), including redirecting received email messages to a screening server (i.e., virus scanning server, see figure 1, unit 7) [page 2, 0035-0036]. Hypponen teaches a recipient computer comprising software instructions for forwarding email messages received to the email screening server [page 2, 0035-0036 and page 3, 0040-0041].

Appellant further pointed out differences between the claimed invention and other prior arts including Ji et al, Kim et al, Aronson et al, Franczek et al, Tso et al, Dickenson et al and Chen et al. Examiner would point out that those references are not part of the rejections. It is reminded to the appellant that the appealed claims are rejected over Council, Hypponen and Hardy. Examiner wished to have no comments on the indirect prior arts.

Grounds II

With respect to claims 2-4 and 6-7, Appellant further argued that the office action fails to provide proper motivation in combining Hardy et al. with Council and Hypponen et al.

In response to appellant's argument that there is no suggestion to combine Hardy et al, with Council and Hypponen, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Council teaches a recipient computer connected

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to an email-screening server [see Council, column 3, lines 14-19 and figure 1]. Council further teaches the use of an authorization list. Hypponen teaches a recipient system (mail server and user work stations, see figure 1, unit 4b & 2a-d) comprising software instruction for forwarding email messages to email screening server (virus scanning server see figure 1, unit 7) [see page 2, 0035-0036 & 0040-0041]. The teachings of Hypponen wherein received email message is redirected to a screening server [page 2, 0035-0036] can be employed within Council's recipient computer and screening server in order to allow centralized email screening by forwarding received email to a screening system [see Hypponen, page 1, 0003]. Furthermore, Hardy teaches the use of passwords as a means of authorization [Column 9, 15-17]. The teachings of Hardy wherein passwords are used for authorization can be employed within council's authorization list. Hardy can be employed within the system of Council and Hypponen in order to allow efficient authorization because such lists are difficult to keep.

Appellant further argued that neither Council nor Hypponen et al. suggest and desirability of or need for authorization keys and signatures used for encryption and verifications as taught by Hardy et al. As such, Appellants submit that the Office Action rejection has used impermissible hindsight to combine the references.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to claim 3, Appellant argued that the art on record fails to teach software instructions for holding all email messages without password.

Examiner would point out that holding all email message without password is included in the Council-Hypponen system, since if the sending part is not authorized to send e-mail to the recipient then the party is asked to provide a fee for the delivery to the recipient [Council, column 1, lines 28-33 and column 2, lines 33-44]. Council further teaches allowing storage of the message when address that is not in the list of authorized address is received [see Council column 2, lines 33-44].

Appellant's arguments with respect to claims 5, 8, 9, 14 and 15 have been fully considered and are persuasive. The rejection of claims 5, 8, 9, 14 and 15 has been withdrawn.

With respect to claims 11-13, Appellant argued that claims 11-13 are allowable for the same reason identified above with respect to claim 10 since the base combination of Council and Hypponen et al. failed to establish a prima facie case of obviousness. The addition of Hardy et al. fails to cure any of the defects of the base combination. Hardy et al., like Council and Hypponen et al., fails to teach a recipient computer re-routing received email from the recipient computer to a screening server over a network as required by base claim 10.

Examiner would point out that, Hypponen et al teaches a recipient computer (i.e., mail server and user workstations, see figure 1, units 4b & 2a-d), including redirecting received email messages to a screening server (i.e., virus scanning server, see figure 1, unit 7) [page 2, 0035-0036]. Hypponen teaches a recipient computer comprising software instructions for forwarding

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email messages received to the email screening server [page 2, 0035-0036 and page 3, 0040-0041].

Appellant further argued the propriety of combining Hardy et al. with Council and Hypponen et al. Appellant argued that an authorization list for email delivery of Council is quite different from authorization keys and signatures used for encryption and verification, as taught by Hardy et al. Neither Council nor Hypponen et al. suggest any desirability or need for authorization keys and signatures for encryption and verification as taught by Hardy et al. As such, Appellants submit that the Office Action rejection has used impermissible hindsight to combine the references.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Examiner would point out that Council teaches a recipient computer connected to an email-screening server [see Council, column 3, lines 14-19 and figure 1]. Council further teaches the use of an authorization list. Hypponen teaches a recipient system (mail server and user work stations, see figure 1, unit 4b & 2a-d) comprising software instruction for forwarding email messages to email screening server (virus scanning server see figure 1, unit 7) [see page 2, 0035-0036 & 0040-0041]. The teachings of Hypponen wherein received email message is redirected to a screening server [page 2, 0035-0036] can be employed within

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Council's recipient computer and screening server in order to allow centralized email screening by forwarding received email to a screening system [see Hypponen, page 1, 0003].

Furthermore, Hardy teaches the use of passwords as a means of authorization [Column 9, 15-17]. The teachings of Hardy wherein passwords are used for authorization can be employed within council's authorization list. Hardy can be employed within the system of Council and Hypponen in order to allow efficient authorization because such lists are difficult to keep.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Beemnet Dada


03/27/2006

Conferees:

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